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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965.

No. 612

M. B. SKINNER COMPANY,

Petitioner,

vs.

CONTINENTAL INDUSTRIES, INC.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT.

CHARLES J. MERRIAM,
NORMAN M. SHAPIRO,
ALLEN H. GERSTEIN,
Attorneys for Petitioner.

Of Counsel:
MERRIAM, MARSHALL, SHAPIRO & KLOSE,
30 West Monroe St.,
Chicago, Illinois, 60603.

THE SOUTHWORTH-ANTHON PRINTING COMPANY, CHICAGO

TABLE OF CONTENTS.

	PAGE
Opinions Below	1
Jurisdiction	2
Questions Presented	2
Statement of the Case	2
Reasons for Granting the Writ	5
1. The Court Applied a Non-Statutory and Improper Test of Patentability	5
2. The Court Erred in Holding That Claims 1, 2 and 3 of Patent 2,990,731 Are to a Combination of Old Elements	11
Conclusion	14
Appendix	17

TABLE OF CASES.

Admiral Corp. v. Zenith Radio Corp., 296 F. 2d 708 (10th Cir. 1961)	6
Calmar, Inc. v. Cook Chemical Company, cert. granted, 13 L. Ed. 2d 967 (Case No. 37) case below reported at 336 F. 2d 110 (8th Cir. 1964)	10
Consolidated Electrodynamic Corp. v. Midwestern Instruments, Inc., 260 F. 2d 811 (10th Cir. 1958)	6
Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84, 86 L. Ed. 58 (1941)	8
Ex Parte Jepson, 243 O. G. 525 (1917)	13
Graham v. John Deere Co., cert. granted, 379 U. S. 956 (Case No. 11) case below reported at 333 F. 2d 529 (8th Cir. 1964)	10

Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp., 340 U. S. 147 (1950) 8

Harris v. National Machine Works, Inc., 171 F. 2d 85 (10th Cir. 1948), cert. denied, 336 U. S. 905 (1949) .. 13

Oliver United Filters, Inc. v. Silver, 206 F. 2d 658 (10th Cir. 1953) 6

Shaffer v. Armer, 184 F. 2d 303, 307 (10th Cir. 1950) .. 5

U. S. v. Adams, cert. granted, 13 L. Ed. 2d 968 (Case No. 55), case below reported at 330 F. 2d 622 (Ct. Cl. 1964) 10

United States v. El Paso Natural Gas Co., 376 U. S. 651, 656 (1964) 15

Williams Mfg. Co. v. United Shoe Machinery Corp., 316 U. S. 364 (1942) 12

STATUTES.

28 U. S. C. § 1254(1) 2

35 U. S. C. § 103 .....2, 5-11, 14, 17

35 U. S. C. § 102 9

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Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT.

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Tenth Circuit entered in the above-entitled case on June 1, 1965.

OPINIONS BELOW.

The district court gave an oral opinion not officially reported. The transcript of this opinion and the findings of fact and conclusions of law adopted by the district court are included in the appendix attached hereto. The decision of the Court of Appeals for the Tenth Circuit is reported at 346 F.2d 170 (10th Cir. 1965). A copy of that decision is also included in the appendix.

JURISDICTION.

The judgment of the United States Court of Appeals for the Tenth Circuit was entered on June 1, 1965 (App., *infra*, p. 25). A timely petition for rehearing was denied July 7, 1965 (App., *infra*, p. 25).

The jurisdiction of this Court is invoked under 28 U. S. C. § 1254(1).

QUESTIONS PRESENTED.

1. Did the Court of Appeals for the Tenth Circuit err in holding that a new and useful combination of elements must accomplish a new and useful result and, in addition, be inventive in order to be patentable even though 35 U.S.C. § 103 only requires that the thing invented not be obvious to those skilled in the art?

2. Did the Court of Appeals for the Tenth Circuit err in holding that claims 1, 2 and 3 of Patent No. 2,990,731 are to a combination of elements when the claims are clearly directed to only one element?

STATEMENT OF THE CASE.

Petitioner, M. B. Skinner Company, instituted this action against Continental Industries, Inc. in the Northern District of Oklahoma alleging infringement of petitioner's patents No. 2,950,637 and No. 2,990,731. Upon completion of a three day trial and without the benefit of oral argument or post trial briefs (both of which were waived by the parties) the trial judge delivered an abbreviated opinion from the bench holding both patents invalid and not infringed. At the request of the trial judge, counsel for respondent prepared and submitted findings of fact and conclusions of law which were adopted verbatim (App., *infra*, pp. 28-42).

On appeal, the judgment was affirmed. The court of appeals did not, however, discuss infringement in view of the finding of invalidity.

The devices here in question relate to means for making a tap or service connection into a high pressured gas line without interrupting service or losing gas. The method previously used usually involved a drilling device connected to a T-fitting welded to the line and used to drill a hole in the pipe wall. Such drilling devices were expensive, costly to maintain and were relatively tedious to set up and use. Most importantly, the chips and cuttings necessarily formed by the drill entered the pipe line and created the possibility of clogging regulatory valves and various service connections.

In an effort to avoid these disadvantages, plaintiff first developed the *punching* T-fitting of Patent 2,950,637, and the further improved punch of Patent 2,990,731.

A drill cuts away either a ring or all the metal in the pipe leaving a troublesome residue of shavings, filings and chips. The punches here involved punch out a single innocuous coupon of metal by cold flow, just as one would punch a hole in cheese.

The punching T-fitting is secured to the pipe to be tapped. The outer part of the punch is threaded into the interior of the T-fitting. Rotation of the punching tool causes it to advance and push metal, by cold flow, ahead of it. As the punch revolves and progresses into the pipe the inner pipe surface bulges from the punch pressure and a slug or coupon is formed which drops into the pipe. No detached chips are formed and the problems previously encountered are thus avoided.

After the hole has been punched in the pipe, the punch member is retracted to permit gas or other fluid under pressure to flow through the pipe hole. The threaded outer

end of the punch member seals the tubular fitting at its threaded interior when in a retracted position.

Petitioner's punching T-fitting provided *for the first time*, a small, inexpensive, simple, self-contained unit usable for making tap or service connections in a distribution line. By punching out a coupon, the formation of troublesome chips and shavings, always present when a drilling operation is used, is eliminated. Also, the time and effort required for the operation is greatly reduced.

The tip of the tool claimed in Patent 2,950,637 is comprised of a single oblique plane. It was found that in some instances the coupon formed in the punching operation did not break entirely loose and could, under certain circumstances swing back into its original position and obstruct the tap connection. Also, the punch tip sometimes wandered from the straight axial path during the operation. The improved punching tip was designed and patented and is the basis for Patent 2,990,731. In the improved punch the tip of the punch is provided with a surface formed by at least two intersecting planes and having a central hole in the tip. In making the tap, some metal from the pipe wall flows as a core into the central hole of the punch tip. This core holds the punch axially during the punching operation and in the last stage of the hole forming operation, insures that the coupon will be severed from the pipe wall. The improved punch requires less torque than the first punch and is thus easier to operate manually.

As stated by the court below:

> "The accused punch marketed by appellee is similar in all respects to appellant's improved punch except that the tip is made up of three, rather than two, intersecting planes. There is no other important difference between the two punches. Both punches swage a hole in the pipe and both produce a coupon." 346 F.2d at 173.

REASONS FOR GRANTING THE WRIT.

1. The Court Applied a Non-Statutory and Improper Test of Patentability.

The statutory standard of patentability is set forth in 35 U.S.C. § 103 and provides that a patent is to be granted unless "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. . . ."

Although the court of appeals made reference to the statutory test of patentability in 35 U.S.C. § 103, it failed to apply this test.

The erroneous test of patentability applied by the court below was stated, in part, as follows:

> ". . . since it is a combination of old elements appellant must show both that it accomplishes a new and useful result and is inventive."

The district court made no reference to 35 U.S.C. § 103 in its oral opinion (App., *infra*, pp. 26-27) but quoted from *Shaffer* v. *Armer*, 184 F.2d 303, 307 (10th Cir. 1950): "The device must not only be 'new and useful,' it must also amount to 'invention or discovery.'" It should be noted that the *Shaffer* decision was delivered prior to the passage of 35 U.S.C. § 103.

The tests applied by the courts below are not the statutory test, nor the law as defined by the Tenth Circuit, neither of which requires that a new and useful combination of old elements accomplish a *new result* or that the combination be *inventive*. Certainly, the statute does not require *both* a new result and inventiveness. The statute only requires that the combination be unobvious to one skilled in the art.

The Court of Appeals for the Tenth Circuit has held that no new result need be shown for a new combination of old elements to be patentable. *Admiral Corp.* v. *Zenith Radio Corp.*, 296 F.2d 708 (10th Cir. 1961), held a combination of old elements is patentable if it accomplishes an *old result* in a more facile, economical and efficient way in a particular environment which presented peculiar and difficult problems. See also *Consolidated Electrodynamic Corp.* v. *Midwestern Instruments, Inc.*, 260 F.2d 811 (10th Cir. 1958), and *Oliver United Filters* v. *Silver*, 206 F.2d 658 (10th Cir. 1953).

Here, the trial court said of petitioner's invention: "It's a *useful* device and it's an *improvement* over what has been shown by the evidence over a long period of years. It's an accumulation of ideas that were put together and we come up with a *very unique device* and it's *more useful* than any device we have had before." (Emphasis added.)

The primary rule in determining patentability is set forth in 35 U.S.C. § 103. The statute provides that patentability exists if the subject matter is not obvious from the prior art to one skilled in the art at the time the invention is made. It is the primary test of patentability.

Over the years the courts have established many secondary indicia or rules of patentability, both positive and negative, which have served as guides in the application of the primary rule of patentability, namely, lack of obviousness to the ordinary person skilled in the art.

Most of these secondary indicia are on the negative side. It has been held that a mere change in size, shape, form or degree is not patentable i.e., the change would have been obvious to those skilled in the art.

On the positive side some of the secondary indicia of patentability are: long-felt want, failure of others, commercial success, production of a new result, acceptance by

the industry, and copying by the infringer. While no court, to our knowledge, has fallen into the error of applying the positive secondary indicia as conclusive presumptions of patentability, many courts have erroneously applied the negative secondary rules as if they conclusively established invalidity.

Whatever may have been the law prior to 1952, the present Patent Act, 35 U.S.C. § 103, makes obviousness the final and only test and requires that all of the secondary indicia, either positive or negative, be subordinated thereto.

In the present case, many of the positive secondary criteria of invention are present, *e.g.*, commercial success and copying by the infringer.

The court below fell into the not uncommon error of finding a patent invalid because one of the secondary indicia of patentability was not present. It is petitioner's position that failure to find a new result from the combination of old elements has no bearing on whether the improvement was obvious to those skilled in the art.

The two patents in suit meet the statutory requirement of *unobviousness* as measured by the primary rule and supporting positive secondary rules.

The court of appeals and the district court further erred in holding that the combination must be *inventive* to be patentable. The statute merely states that the combination must be unobvious to one skilled in the art. It says nothing about the combination being *inventive*.

Petitioner does not object to the use of such terms as "invention" or "inventiveness" when it is clear they are intended to be synonymous with unobviousness only. The district court found all the necessary factual criteria for unobviousness under the statute, but applied only a non-statutory test of *inventiveness i.e.*, one not equated with unobviousness, in holding the patents invalid. As applied

by the district court; the *inventiveness* test is unmistakably synonymous with the "flash of genius" test of *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84 (1941).

The decisions of the Supreme Court in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equip. Corp.*, 340 U. S. 147 (1950), and *Cuno Engineering Corp.* v. *Automatic Devices Corp., supra,* were critical factors behind Congress's revision of the law pertaining to the showing needed for patentability. In 35 U. S. C. § 103, Congress did not adopt a standard which required a showing of invention. It simply required that unobviousness to those skilled in the art be the basis for judging patentability. It did not adopt the "flash of genius" test of the Supreme Court but replaced it by the statute.

The Senate report to accompany H. R. 7794,[1] the bill which became the Patent Act of 1952, stated that the "purpose of the proposed legislation is to *revise* and codify the laws relating to patents"[2] (emphasis added). With respect to the requirement for invention in Section 103, which the report described as one of the "major changes or innovations in the title,"[3] the Report stated[4]:

> "Section 103, for the first time in our statute, provides a condition which exists in the law and *has existed for more than 100 years,* but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same

1. Senate Report No. 1979, June 27, 1952, 82nd Congress, Second Session. The House Report (House Report No. 1923, May 12, 1952) was substantially the same. The Senate Report may be found in 2 U. S. Cong. News, 1952, 82nd Cong., Second Session, at pages 2394-2428.

2. 2 U. S. Cong. News, 1952, 82nd Cong., Second Session at 2394.

3. *Id.* at 2397.

4. *Id.* at 2399 and 2400.

thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in Section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.

"That provision *paraphrases language which has often been used in decisions of the courts,* and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and *minimize great departures which have appeared in some cases.*" (Emphasis added.)

Judge Giles S. Rich, Associate Judge of the Court of Customs and Patent Appeals, commenting on the Principles of Patentability in 42 J. PAT. OFF. SOC'Y 75, 89-90 (1960) stated:

"Nowhere in the entire act [Patent Act of 1952] is there any reference to a requirement of 'invention' and the drafters did this deliberately in an effort to free the law and lawyers from bondage to that old and meaningless term. The word 'invention' is used in the statute only to refer to the thing invented. That is why the requirement of 'invention' should be referred to, if at all, only with respect due to that which is dead.

* * * * *

"The question will, of course, be asked, 'What difference does it make, it must still be a subjective decision?' True, but now the statute provides a standard according to which the subjective decision must be made. There is a vast difference between basing a decision on exercise of the inventive or creative faculty, or genius, ingenuity, patentable novelty, flashes, surprises and excitement, on the one hand, and basing it on unobviousness to one of ordinary skill in the art on

> the other. It is possible to determine what art is involved, what type of skill is possessed by ordinary workers in it, and come to some conclusion as to what 'ordinary skill' would be at a given time. This may present knotty problems but it is a definite pattern of thinking and does not leave the Patent Office or the courts free to conclude that a thing is not patentable for any old reason and then stand on the proposition that something indefinable and impalpable called 'invention' was not involved. At least they have to talk in terms of obviousness to a man of ordinary skill in the art. While the ultimate decision as to what his skill would be and what would be obvious to him is subjective, it is one definite proposition on which evidence can be adduced."

To date, this Court has not passed on the present statutory test of unobviousness. Presumably, it will do so during the October, 1965 term in the following three cases: *Graham* v. *John Deere Co.*, cert. granted, 379 U. S. 956 (Case No. 11) case below reported at 333 F. 2d 529 (8th Cir. 1964); *Calmar, Inc.* v. *Cook Chemical Company,* cert. granted 13 L. Ed. 2d 967 (Case No. 37) case below reported at 336 F. 2d 110 (8th Cir. 1964); and *U. S.* v. *Adams,* cert. granted, 13 L. Ed. 2d 968 (Case No. 55) case below reported at 330 F. 2d 622 (Ct. Cl. 1964).

The present case is equally important in establishing a clear and definitive construction of 35 U.S.C.§ 103 and therefore deserves review by this Court to effect the orderly administration of justice.

Graham v. *John Deere Co., supra,* was cited as authority by the court below for the proposition: "The standards of originality necessary to sustain a patent based upon a combination of old elements are properly burdensome." 346 F.2d at 174. This asserted standard involves a non-statutory test of patentability inherently more stringent than expressly called for by Congress. The Court thus further erred.

2. The Court Erred in Holding That Claims 1, 2 and 3 of Patent 2,990,731 Are to a Combination of Old Elements.

As already stated, the court below adopted a standard of patentability for combinations of old elements different from the standard set out in 35 U.S.C. § 103. It applied this standard to both Patents 2,950,637 and 2,990,731 even though claims 1, 2 and 3 of 2,990,731 (the only claims of that patent in issue) were not directed to a combination of old elements. The opinion of the court below indicates it did not fully appreciate that claims 1, 2 and 3 of petitioner's Patent 2,990,731 are directed solely to a single element, the improved punching tip. That these three claims were treated as combination claims is clear from the statement by the court:

> "Appellant's claims of invention therefore are based upon what is said to be a new combination of elements, and since it is a combination of old elements appellant must show both that it accomplishes a new and useful result and is inventive." 346 F.2d at 173.

and further:

> "However, a mere difference in the number of planes and corresponding apexes, if inventive, suggest severable patentability rather than combination;" 346 F.2d at 174.

Claim 3 is illustrative of the claims of Patent 2,990,731 in suit:

> "3. In means for perforating a wall of a steel member of substantially uniform thickness, comprising a tube secured to said wall to extend substantially perpendicularly to said wall and having an internally threaded end portion spaced from said wall and an elongated perforating tool screw-threaded at one end thereof to mate with said tube threads and formed of a metal harder than said wall, said tool having a reduced diameter substantially cylindrical concentric

perforating end portion having an oblique end face, *the improvement comprising an axial concentric bore in said perforating end portion open at said end face and of a depth greater than the thickness of said wall, said end face having a V-shaped profile defined by two oblique planes intersecting diametrically of said end face and displaced between 140 deg. and 160 deg.*" (Emphasis added.)

The inventive subject matter as set forth in the claim is directed to the punching tip having an axial, concentric bore and an end face formed by two intersecting oblique planes forming a V-shaped profile. This is the dominant element of the invention as claimed. No punching tip having the recited features was disclosed or taught by the prior art, and no punching tip of the prior art could be substituted for the punching tip as claimed without making substantial modifications. In fact, the court below stated: "There is no single aspect of appellant's T-fittings that is totally new, *with the possible exception of the punching tip which is different from the prior art relied upon by appellee and the Patent Office.*" (Emphasis added.) 346 F.2d at 173.

The tube or T-fitting is not part of the claimed invention, nor is the threaded portion of the T-fitting or the tool. The introductory clause reciting these features is not an element of the claimed subject matter, and does not render the claim a combination claim.

An essentially identical question was before this Court in *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364 (1942). The claims in suit were to machinery for use in the manufacture of shoes, and were attacked by the defendant-infringer as being directed to a combination of old elements and, hence, invalid. This Court discounted this contention, and upheld both courts below which found that each claim embodied improvements and exhibited invention. A number of the claims in suit were prefaced with an intro-

ductory clause which the Court ruled at page 369 as "properly used to specify the type of machine in which the *claimed subsidiary* combination of elements works an improvement over the prior art." (Emphasis added.) Continuing, the Court held:

> "[I]t was necessary to make reference to certain portions of the machine in connection with which the new combinations were to operate and with which they were to dovetail, but, in mentioning these other mechanical parts, the claim does not purport to embody them as elements of the claimed combination. To construe such a claim for a combination of new elements intended to be embodied in some well recognized mechanical aggregation, such as a sewing machine or a washing machine, as a claim covering all the mechanical details, or all the well known parts of the machine, would be to nullify every patent for an improvement in a type of machine long in use and would invalidate thousands of patents for improvements in standard machines. It would be difficult to describe an improvement in a washing machine without naming such a machine as the thing to which the patent is addressed and equally difficult to refrain from referring to various parts of the machine, such as the tub or the motor which actuates the washer. But it has never been thought that a claim limited to an improvement in some element of the machine is, by such reference, rendered bad as claiming a monopoly of tubs or motors used in washing machines."

The practice of employing this type of claim[5] has been sanctioned by the courts and Patent Office for nearly half a century. In fact, this type of claim was upheld in the Tenth Circuit in *Harris* v. *National Machine Works, Inc.*, 171 F.2d 85 (10th Cir. 1948), cert. denied, 336 U. S. 905 (1949).

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5. Commonly referred to as a "Jepson claim," the term emanating from the decision in *Ex Parte Jepson*, 243 O. G. 525 (1917).

The improved punch tip, *per se*, and not the combination is clearly all that claims 1, 2 and 3 of appellant's Patent 2,990,731 cover. It is only the improved punching tip which is claimed and not the remaining elements of the T-fitting in which the punching tip is used. Thus, the court below erred in this suit in holding that a combination was claimed rather than only the punching tip itself. This error is particularly unfortunate in view of the court's statement: "There is no single aspect of appellant's T-fittings that is totally new, with the possible exception of the punching tip which is different from the prior art relied upon by appellee and the patent office." 346 F. 2d at 173.

CONCLUSION.

The court of appeals and the district court erred in applying a standard of patentability for combinations of elements inconsistent with 35 U.S.C. § 103. The court of appeals compounded this error by considering claims 1, 2 and 3 of Patent No. 2,990,731 as claims to a combination. Further, the findings of fact and conclusions of law submitted by defendant at the request of the trial court and adopted verbatim should have been discounted entirely.

It is not uncommon in patent cases for the district court to base its decision *in toto* on findings of fact and conclusions of law. This practice is repugnant to the spirit of Rule 52(a) when the court adopts verbatim the findings and conclusions prepared by the prevailing party at the request of the court. The rule specifically provides that "the *court shall find* the facts specially and state separately its conclusions of law thereon. . . ." (Emphasis added.) Findings and conclusions submitted by the prevailing party and adopted verbatim by the court are findings and conclusions phrased in the language and tenor of an advocate rather than that of an impartial court.

This Court recently criticized the wholesale adoption of findings and conclusions prepared by the prevailing party, and quoted at length Judge J. Skelly Wright's condemnation of such practice. *United States* v. *El Paso Natural Gas Co.*, 376 U. S. 651, 656 (1964). Does not this foretell of a judicial denouncement of this practice? A definitive ruling is timely.

It is painfully obvious that partisan findings reflect the bias of that party. If, as Judge Wright stated, the findings are to assist "the court of appeals in determining why the judge decided the case" then these findings clearly fail to fulfill that purpose. Appellee-respondent argued below, however, that the findings were prepared along lines directed by the trial court. But the very fact that the oral opinion from the bench contains significant inconsistencies,[6] manifests the impossibility of complying with this direction and reveals the "clearly erroneous" nature of the findings. The findings also fail to reflect the trial judge's opinion that the device was "very unique" and "more useful than any device we had before," and consequently are "clearly erroneous." Moreover, the findings (App., *infra*, pp. 28-42) as submitted and adopted by the court extended far beyond the course charted in the trial court's opinion (App., *infra*, pp. 26-27). The findings list numerous allegedly anticipatory references which are said to be directed to a punch when in fact these references are explicit to a drill, a piercing needle or other device.[7]

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6. For example, the 5th paragraph of the opinion (App., *infra* p. 27) includes the statement: "The device is not new." However, the same paragraph includes: "It's an accumulation of ideas that were put together and we come up with a very unique device and it's more useful than any device we have had before."

7. Finding 8 (App., *infra*, p. 30) as submitted and adopted says that Australian Patent No. 138,216 of July 24, 1947 to Mercer disclosed ". . . a punch having an oblique end face." The patent itself says that it relates to a ". . . drill or press to bore holes in timber." In column 3 of that reference it is stated ". . . the particles of wood

The findings are not supported by the evidence and run afoul of Rule 52(a).

For the above stated reasons, a writ of certiorari should be granted.

Respectfully submitted,

CHARLES J. MERRIAM,
NORMAN M. SHAPIRO,
ALLEN H. GERSTEIN,
Attorneys for Petitioner.

Of Counsel:
MERRIAM, MARSHALL, SHAPIRO & KLOSE,
30 West Monroe St.,
Chicago, Illinois, 60603.

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cut from the hole passing freely up through the groove." Mercer is, as it says, a drill, not a punch.

In Finding 9 (App., *infra* p. 30), a number of references are referred to as punches—for example, Alsaker 1,638,230. Page 5 of that patent, claim 1, refers to the device as having "extending cutting edges." The same finding refers to McDonald Re 24,199 as being a punch. Actually, McDonald shows a needle-like perforating member. Claim 1 refers to it in col. 3, line 38, as a "piercing needle."

Finding 10 (App., *infra* pp. 30-31) found that McDonald piercing needle was a direct anticipation of plaintiff's punch.

That many of these references showed drills rather than punches was admitted by counsel for respondent at the hearing in the court below.

APPENDIX.

Pertinent Statute Involved
35 U. S. C. Section 103.

§ 103. *Conditions for patentability; non-obvious subject matter.*

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

UNITED STATES COURT OF APPEALS.

Tenth Circuit.

May Term, 1965

M. B. SKINNER COMPANY, a division of Textron Inc., a Rhode Island corporation,

Appellant,

vs.

CONTINENTAL INDUSTRIES, Inc., an Oklahoma Corportion,

Appellee.

No. 7739.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF OKLAHOMA.

Before MURRAH, *Chief Judge,* LEWIS, *Circuit Judge,* and DOYLE, *District Judge.*

LEWIS, *Circuit Judge.*

Appellant, M. B. Skinner Company, brought this action in the Northern District of Oklahoma against appellee Continental Industries, Inc., alleging infringement by Continental of appellant's patents 2,950,637 and 2,990,731, related to punching T-fittings primarily used for making service taps or connections to steel natural gas pipelines. Appellee denied infringement, claimed that the patents were invalid, and counterclaimed for a declaratory judgment to such effect. After a trial to the court, judgment favoring appellee on all issues was entered. Appellee's

counsel thereafter prepared detailed findings of fact and conclusions of law, which the court adopted verbatim. From the judgment holding the patents invalid and not infringed appellant prosecutes this appeal.

Appellant's punching T-fitting, first embodied in its patent number 2,950,637, is designed to be secured at one end to the pipe to be tapped and to extend outward radially from the pipe. The punching element itself fits inside the T-fitting and has a threaded outer end and a punching tip at the inner end, with the threaded end fitting into the threaded interior of the T-fitting. Rotation of the punch causes it to advance at a rate determined by the thread pitch, and in so advancing it pushes the metal ahead of it, producing a metal coupon upon completion of the punch. The face of the punching tip is flat and oblique rather than being perpendicular to the axis of the punch. It is cut at a 15 degree angle, which was found to obtain the most efficient punching action.

The punch tip is smaller in diameter than the threaded part of the punching element. After the hole has been punched in the pipe, the tip is retracted by reverse threading to permit the gas to flow through the pipe hole. The threads on the opposite end of the fitting act as a seal against the escape of the gas from the pipe, leaving only the third member of the tee open for the passage of gas. The punch also has a tapered section between the tip and the threaded portion so that the flow of gas may be shut off by advancing the punch until the tapered portion is firmly seated in the hole; in this way the T-fitting may be used as a valve.

Appellant emphasizes the distinction between a punch and a drill. A punch such as appellant's involves the cold flow of metal and, like a paper punch, produces a coupon rather than shavings which would result from drilling.

Punching which utilizes the cold flow of metals is a form of swaging. By punching, rather than drilling, appellant's T-fitting makes it possible to tap a pipe much faster than before and avoids the production of shavings, which are likely to cause trouble if they remain inside the pipe.

This first T-fitting was marketed by appellant in the first half of 1959 but was not entitrely satisfactory. Because an oblique rather than perpendicular tip was used, the first contact made with the pipe by the tip was eccentric, rather than concentric, to the threaded portion of the punch. This caused the tip to wander somewhat from the axis of the punching element and sometimes to break. Also, on some occasions the coupon formed by the punching did not break entirely loose but remained hinged at the edge of the hole on the inside of the pipe, resulting in the possibility that it might subsequently swing back to obstruct the hole. Because of these shortcomings, appellant developed and marketed an improved punch, the subject of patent number 2,990,731, which had the same structure but a different punching tip. The tip on this punch is formed of two intersecting planes, with a central hole positioned axially of the punching element. The central hole and the two apexes, formed by the two points of intersection of the planes, keep the punch from wandering. The improved tip also solved the problem of the coupon not breaking completely loose from the inside wall of the pipe. This second punch accounts for the majority of appellant's sales and was found by the District Court to be "a useful device."

The accused punch marketed by appellee is similar in all respects to appellant's improved punch except that the tip is made up of three, rather than two, intersecting planes. There is no other important difference between the two punches. Both punches swage a hole in the pipe and both produce a coupon.

Preliminarily, appellant urges that our review of this case should be in the nature of a consideration de novo; that the findings of the district court should not receive the benefit of the clearly erroneous rule because such findings were prepared by counsel and adopted by the court without change; and further, that such findings were based in part upon the erroneous consideration of the testimony of a witness, a patent expert but not expert in the art, who was incompetent to testify but was allowed to testify to ultimate conclusions. We would consider such arguments to have merit only if the over-all record indicated an abandonment of the judicial process by delegation of the decision-making function to counsel and witness. Such is not this case, and although we do not commend the practice of the verbatim adoption of findings prepared by counsel,[1] such findings "are not to be rejected out of hand, and they will stand if supported by evidence." *United States* v. *El Paso Natural Gas Co.*, 376 U. S. 651, at 656. Nor is it improper for the trier of the facts to consider the opinion evidence of an expert upon technical subjects, the value of such opinion being left to the sound discretion of the trial court in view of the qualifications of the expert. The judicial function requires an understanding of the case and the record here negatives and inference of inadequacy in such regard. See *Lorenz* v. *General Steel Products Co.*, 5 Cir., 337 F2 726, 727, n. 3, and authorities there cited.

Although this case is presented with the complexity typical in patent controversies, the critical finding of the trial court is that appellant's claims are premised upon an old and exhausted combination, thus indicating a primary appellate inquiry into the issue of validity, see *Sears, Roebuck & Co.* v. *Jones*, 10 Cir., 308 F2 705, cert. denied, 371 U. S. 952, which is ultimately a question of law for the court to decide. *Mott Corp.* v. *Sunflower Indus-*

1. *Roberts* v. *Ross*, 3 Cir., 344 F. 2d 747, decided April 29, 1965.

tries, Inc., 10 Cir., 314 F2 872. The statutory test to determine validity is whether "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art * * *." 35 U. S. C. § 103. The statute presents an ultimate question of fact, and the trial court's finding of obviousness is safeguarded by the clearly erroneous rule so long as this ultimate factual conclusion was arrived at by consideration of proper legal criteria. Rule 52(a), Fed. R. Civ. P.; *Admiral Corp.* v. *Zenith Radio Corp.*, 296 F2 708, 714; see *Thompson Spot Welder Co.* v. *Ford Motor Co.*, 265 U. S. 445, 446. And while a duly issued patent is presumed to be valid, 35 U. S. C. § 282; *Bewal Inc.* v. *Minnesota Mining & Mfg. Co.*, 10 Cir., 292 F2 159, 163, this presumption is rebuttable, particularly where, as here, much of the prior art relied upon by appellee was not considered by the patent office. *Admiral Corp.* v. *Zenith Radio Corp., supra,* at 712.

There is no single aspect of appellant's T-fittings that is totally new, with the possible exception of the punching tip which is different from the prior art relied upon by appellee and the patent office. Appellant's claims of invention therefore are based upon what is said to be a new combination of elements, and since it is a combination of old elements appellant must show both that it accomplishes a new and useful result and is inventive. *Williams Iron Works Co.* v. *Hughes Tool Co.*, 10 Cir., 109 F2 500. A new application of an old device, or a new combination of old elements is by itself not patentable. 2 Deller's Walker on Patents, 2d Ed., p. 298; *Admiral Corp.* v. *Zenith Radio Corp., supra,* at 213; *Tropic-Aire Inc.* v. *Cullen-Thompson Motor Co.*, 10 Cir., 107 F2 671, 673. The standards of originality necessary to sustain a patent

based upon a combination of old elements are properly burdensome. *Ditto, Inc.* v. *Minnesota Mining & Mfg. Co.*, 8 Cir., 336 F2 67; *John Deere Co.* v. *Graham*, 8 Cir., 333 F2 529, cert. granted, 379 U. S. 956.

In reference to appellant's first patent, number 2,950,637, several of its aspects will be briefly evaluated. First, a branch or T-type fitting containing its own perforating element is not new; it was anticipated by, *inter alia*, McDonald original patent number 2,608,989, in 1952, and Webber, patent number 2,736,335, in 1956. The idea of punching rather than drilling a metal pipe is not inventive in and of itself, and in any case was done by McDonald, *supra*, and Hunter, patent number 2,660,192, in 1953. The principle of using cold flow swaging, producing a coupon after punching or cutting a hole in pipe, was anticipated by Alsaker, patent number 1,638,230, in 1927. The idea of an oblique end face appeared in Mercer, Australian patent 138,216, in 1947, in Pevey, patent number 2,606,615, in 1952, and in Dixon, patent number 2,251,701, in 1941. It is true, as appellant points out, that these latter patents all utilized the oblique face for a purpose other than punching, and that none of them had a flat unbroken surface. However, appellant's punching face is not a great variance of these earlier patents, and they would readily suggest it to one of ordinary skill in the art. See *McCullough Tool Co.* v. *Well Surveys, Inc.*, 10 Cir., 343 F. 2d 381, *Admiral Corp.* v. *Zenith Radio Corp.*, *supra*. And since neither the Hunter, Webber, Alsaker, nor Dixon patents were considered by the patent office, the presumption of patent validity is greatly weakened. The District Court's finding that appellant's tee did not satisfy the requirements of section 103 was not clearly erroneous.

Much of what has been said about patent 2,950,637 applies to the second patent, number 2,990,731. The only

question here concerns the different punching-tip configuration. The idea of a perforating tool with a hollowed end was used, *inter alia,* by Metz, patent number 1,020,302, in 1912, and by Alsaker, *supra.* The key to the punching tip, the formation by intersecting planes with a hollow tip, was used by Metz, *supra,* and shown by Alsaker, *supra.* Appellant complains that these inventions are different, since each design embodied more than two intersecting planes. However, a mere difference in the number of planes and corresponding apexes, if inventive, suggests severable patentability rather than combination; and, in any case, appellant was anticipated by Alsaker's statement that "while I have shown four such cutting edges, obviously a less or greater number might be employed without departing from the invention." This statement is of particular significance because the Alsaker patent was not considered by the patent office.

Certain nontechnical legal criteria may be properly considered in the test of patent validity[2] and appellant points with emphasis to evidence indicating commercial success of the subject pipe punch and to a long-felt need in the industry for the instrument. Such evidence may be considered as properly strengthening the presumption of validity but does not necessarily bridge the gap between mechanical skill and invention. *Admiral Corp.* v. *Zenith Radio Corp., supra,* at 714; 2 Deller's Walker on Patents, 2d Ed., p. 307 et seq. The plumbing industry is a crowded field having a continuing need for improved methods and the evidence of industry acceptance of appellant's T-fitting, although ample to indicate a profitable enterprise, falls far short of general industrywide acceptance.

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2. See Note, Subtests of "Nonobviousness": A Nontechnical Approach to Patent Validity, 112 U. Pa. L. Rev. 1169.

We conclude, therefore, that the District Court was correct in holding that appellant's patents are invalid. Since an invalid patent may not be infringed, it is unnecessary for us to consider the question of infringement. Consolidated *Electrodynamics Corp.* v. *Midwestern Instruments, Inc.*, 10 Cir., 260 F2 811.

AFFIRMED.

JUDGMENT.

Seventh Day, May Term, Tuesday, June 1st, 1965.

Before Honorable Alfred P. Murrah, Chief Judge, Honorable David T. Lewis, Circuit Judge, and Honorable William E. Doyle, District Judge.

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Oklahoma and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said district court in this cause be and the same is hereby affirmed.

ORDER DENYING APPELLANT'S PETITION FOR REHEARING.

Twenty-Seventh Day, May Term, Friday, July 2nd, 1965.

Before Honorable Alfred P. Murrah, Chief Judge, Honorable David T. Lewis, Circuit Judge, and Honorable William E. Doyle, District Judge.

This cause came on to be heard on the petition of appellant for a rehearing herein and was submitted to the court.

On consideration whereof, it is ordered by the court that the said petition be and the same is hereby denied.

DECISION OF THE TRIAL COURT.

(R. 268-270)

The Court: In reading the authority of this Court, that is the Tenth Circuit Court, Judge Murrah said in the Schaefer case which I think is perhaps pertinent here, "But the contract we construe is between the patentee and the public, not the patentee and Hughes, and our first inquiry is whether the patentee's conception is a substantial innovation for which society is truly indebted to the patentee," and he cites the Sinclair case, and then he goes on, "The design of the patent law is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in a useful art."

Then he cites some cases and says further, "The device must not only be new and useful, it must also amount to invention or discovery," and he cites some more cases and then says, "Perfection of workmanship, however much it may increase the convenience, extend the use or diminish expense, is not patentable."

Then further the Tenth Circuit Court of Appeals said in the Air Conditioning Corporation versus Governair Corporation, "It is well settled that the mere carrying forward or extended application of an earlier idea or conception of another involving a change only in form, proportion or degree, where the same work is performed in the same way by substantially the same means, although with better results, is not invention."

I am forced to the conclusion that the plaintiff here has performed a perfection of workmanship. Also I am convinced from the evidence there is not a substantial discovery or invention.

Also the Court is of the opinion and finds that there is

not a substantial innovation for which society is truly indebted to the patentee. The device is not new. It's a useful device and it's an improvement over what has been shown by the evidence over a long period of years. It's an accumulation of ideas that are put together and we come up with a very unique device and it's more useful than any device we have had before. Your sales record shows that. But I can't find that it comes within the field of invention.

Now in the pleading of this case, the relief that the plaintiff asked by the complaint will have to be denied from the evidence and the findings of the Court, and based upon the findings; and at this point the Court will not try to relate all of the findings but I will ask the counsel for the defendant to prepare proper findings along the line I have discussed and along the lines that would be proper in a case of this kind.

But the Court does find and conclude that Patent No. 2,950,637 and Patent No. 2,990,731 are invalid, void and unenforceable.

Further, the Court finds and concludes and orders that it is adjudged and determined that the defendant has not infringed any of the claims of said patents which shall be found to be invalid.

Those are the contentions of the defendant and the Court finds that the prayer of the defendant should be sustained.

Anything further from either counsel?

I want to say that counsel for the plaintiff and for the defendant have tried this case, they have brought all the evidence I think that was available, and both counsel have done a very excellent, skillful job of representing your clients in this matter; and I hope I am right.

Court is in recess.

(Whereupon the trial proceedings were adjourned.)

The above entitled cause came on regularly for the trial and the court having duly considered the evidence and being fully advised in the premises now find the following:

Findings of Fact.

(1) The M. B. Skinner Company, a division of Textron Corporation, a corporation of the State of Rhode Island, is plaintiff in this action and is the assignee and owner of the entire right, title and interest in United States Patents No. 2,950,637 and 2,990,731.

(2) The defendant, Continental Industries, Incorporated, is a corporation of the state of Oklahoma, and has its principal office and place of business in the city of Tulsa, Oklahoma.

(3) Jurisdiction of this court arises under the patent laws of the United States, 28 U. S. C. Section 1338.

(4) The devise here accused as an infringement of the patents in suit is identified as Continental's Self Punching T Fitting. The accused device was manufactured and sold by the defendant. As manufactured and sold by the defendant the accused device is comprised of an upstanding tubular body member having threads substantially the full internal length thereof. The body member is adapted to be welded at the lower end thereof to a pipe, such as a pressured gas main. Intermediate the ends of the tubular member is a tubular branch outlet which is affixed at one end to the tubular member and extends substantially at a right angle thereto. The branch outlet provides means for attaching a branch line. Threadably positioned internally of the tubular body member is a cylindrical externally threaded punch member. The punch

member has means at the upper end for receiving a wrench, such as an allen wrench, and at the lower end thereof terminates in a reduced diameter cylindrical end portion. The end portion terminates in a punching face designed to engage and by the rotatable threaded advancement of the punch, to force a hole in the pipe or main to which the tubular body member has been previously affixed. The punching end configuration is tubular or hollow and is best described as being defined by three oblique planes each of which intersects the other at an angle relative to the axis of the punch member so as to define three equally spaced apices. The apices each extend at an angle of approximately 6½ degrees to a plane drawn perpendicular of the axis of the punching member. Each apex is radial of the axis but no two are diametrically aligned.

Findings of Fact Relating to
Plaintiff's 2,950,637 Patent.

(5) In the application by which patent No. 2,950,637 was issued there was submitted a total of 14 claims. Twelve of the claims were allowed by the Patent Office. Of those allowed plaintiff is relying only on Claims 1, 2, 3 and 10.

(6) When Merrill et al. applied for Patent No. 2,950,637 they were not the first to conceive of a branch outlet device to be attached to a pipe for the subsequent perforation of the pipe while the pipe is under pressure as a means of providing a branch line connection. Such a device was shown in a patent to Smith No. 396,177 issued January 15, 1889.

(7) When Merrill, et al. applied for Patent No. 2,950,637 they were not the first to conceive of a T fitting having integral means for punching the pipe to which it was affixed. Such was disclosed in prior patents to McDonald No. Re 24,199, issued August 21, 1956; to Hunter 2,660,192, issued

November 24, 1953; and to Webber 2,736,235, issued February 28, 1956. The patents to Hunter, Webber and Smith above referred to were not considered by the Patent Office in granting patent 2,950,637.

(8) At the time the applicants applied for Patent No. 2,950,637 they were not the first to conceive of a punch having an oblique end face. Such was disclosed in prior patents to Dixon, No. 2,251,701, issued August 5, 1941; to Peevey et al., 2,606,615, issued August 12, 1952; and in an Australian Patent issued July 24, 1947 to Mercer. The patents to Dixon and Peevey were not considered by the examiner.

(9) At the time applicants applied for Patent No. 2,950,637 they were not the first to conceive of a screw thread advanced punch. Such was shown to be old in the patents to McDonald, Re 24,199 issued August 21, 1956; Hunter 2,660,192, issued November 24, 1953; Smith 396,177 issued January 15, 1889; Webber 2,736,335, issued February 28, 1956; and Alsaker 1,638,230, issued August 9, 1927. The patents to Hunter, Smith, Webber and Alsaker were not considered by the examiner. The mode of operation of the device of the plaintiff's 2,950,637 patent wherein a plug, slug or coupon as it is variously called is formed in a pipe is shown in the 1889 patent to Smith. Further, the mode of operation argued to be new and novel by the applicants is shown to be old in the 1927 patent to Alsaker. The Alsaker patent describes the method of using a screw-thread advanced punch to swage a hole in a pipe in substantially the same language applicants used to describe the operation of their device.

(10) Each of the patents to McDonald, Hunter and Webber is an anticipation of plaintiff's 2,950,637 patent. Any difference is the structure of plaintiff's patent and that shown in the prior art patents is limited to the specific punching face configuration described in plain-

tiff's patent as "an oblique end face extending thereacross." Such a punching configuration is anticipated in the prior patents to Dixon, 2,251,701, Peevey, et al., 2,606,615, and Mercer, 11,891.

(11) The adaption of the oblique punching face as shown in the Dixon, Peevey and Mercer patents to the self punching T fittings as shown in the McDonald, Hunter, or Webber patents produces no unobvious results and would be within the ordinary skill of the art. Plaintiff's 2,950,637 patent is anticipated by the prior art. Furthermore, the claims in suit of the said patent do not reflect invention over the prior art.

(12) Claim 2 is a dependent claim from parent Claim 1. As a dependent claim, Claim 2 includes all of the limitations of the Claim 1 and constitutes a further limitation of Claim 1. Claim 2 is distinguished from Claim 1 by the further provision of,

> "a tapered portion intermediate its length and adjacent the pipe-piercing portion, said tapered portion sealing said pipe hole with a wedge fit when said piercing member is advanced inwardly in said fitting."

The patent to McDonald shows a tapered portion intermediate its length and adjacent the pipe piercing portion at numeral 20. This tapered portion is configured to seal the hole formed in the pipe with a wedge fit when the piercing end is advanced inwardly in the fitting. Thus the patent to McDonald completely anticipates the structure of Claim 2 of Patent No. 2,950,637. Furthermore, the provision of a tapered portion to close an opening and function as a valve as set forth in Claim 2 produces no new or unobvious result to a worker ordinarily skilled in the prior art, and does not reflect invention.

(13) Claim 3 is a dependent claim of parent Claim 1 and includes all the elements of and further limits Claim

1. Claim 3 is distinguished from Claim 1 by the provision of a "cap removably and suitably mounted on the outer end of said fitting." The patent to Webber in Figure 9 discloses a cap serving exactly the same purpose in a self punching T fitting as is shown in plaintiff's patent and as set forth in Claim 3. The patent to Webber is a complete anticipation of the distinguishing characteristics of Claim 3. Furthermore, the provision of a cap to close the end of a tubular member as set forth in Claim 3 produces no new or unobvious result that would not be suggested to a worker skilled in the art, and does not amount to invention.

(14) Claims 1, 2, and 3 as originally filed in the application for Patent No. 2,950,637, provided for,

> "a rigid elongated member screw threaded at one end in the outer portion of said fitting and having a reduced opposite end portion configured to engage and pierce a hole in said pipe as it is advanced by rotation."

These claims were rejected by the examiner over the patent to McDonald and the Australian patent to Mercer. To obtain allowance of these claims they were amended to include,

> "a rigid elongated member screw-threaded at one end in the outer portion of said fitting and having a reduced concentric cylindrical end portion having clearance in the tubular part between said pipe and said branch outlet, said reduced end portion having an oblique end face extending thereacross."

These added words represent the thought essential to what the inventors regarded as their new step and their limiting effect cannot be neutralized under the doctrine of equivalency. The accused device does not have such an "oblique end face extending thereacross."

(15) The Australian patent to Mercer cited by the ex-

aminer in the application for plaintiff's Patent No. 2,950,-637, disclosed a drill structure substantially identical to the punching end face of the applicants punching member. The device shown in Mercer differs from the structure of the punching device of plaintiff's patent only by the provision in Mercer of a longitudinal slot. This longitudinal slot constituted an interruption of the oblique face of the Mercer drill. To distinguish over the Mercer disclosure applicants amended Claim 10 by providing that their oblique end face extends "thereacross." The addition of the word "thereacross" to distinguish the claimed structure is a limitation of the claim and the claim must be so construed. In addition, the end face of the accused device is not "flat" as required in this claim.

(16) All of the claims relied upon in plaintiff's 2,950,637 patent are directed to a combination of elements constituting a self punching T fitting. All of the elements making up the claimed combinations are disclosed in each of the prior issued patents to McDonald, Webber and Hunter. The only difference in the claimed structure and the combination of elements shown in these prior issued patents is in the punching end configuration. Having made a purported improvement in this single element patentees did not patent the improved element but claimed the entire combination. The claims are drawn to an old and exhausted combination, and are therefore invalid.

(17) Each of the Claims 1, 2, and 3 of plaintiff's 2,950,-637 patent recite as a positive element thereof, "a steel pipe." This steel pipe typically is a gas main to which the T fitting is affixed for the purpose of attaching a branch line. Such an element is not disclosed in the accused structure therefore these claims are not descriptive of the accused structure.

(18) Each of the Claims 1, 2, 3, and 10 of plaintiffs 2,950,637 patent require a punching tool having an "oblique

end face extending thereacross." This structure is not found in the accused device therefore these claims do not read on the accused device.

(19) Plaintiff's manufactured and sold self punching T fittings as shown in their 2,950,637 patent. The device was taken off the market within a short time after its introduction. Difficulty was experienced in the use of the device. Defendant never manufactured or sold a device having a solid punching face as disclosed in plaintiff's 2,950,637 patent.

Findings of Fact Relating to Plaintiff's Patent No. 2,990,731.

(20) In the application from which Patent No. 2,990,731 issued a total of 12 claims were submitted. After action rejecting all claims, applicants cancelled 7 thereof and amended 4 of the remainder. The patent issued with 5 claims. Plaintiff is relying only upon Claims 3 and 4.

(21) The application for Patent 2,990,731 was filed in the Patent Office on June 29, 1959 and was issued on July 4, 1961. The patent application disclosed two embodiments representing improvements over the self punching T fitting of plaintiff's 2,950,637 patent. The first embodiment is set forth in Figures 1, 2, and 3 of the patent drawings and consists of a punching T fitting as described in plaintiff's 2,950,637 patent with the additional provision of a tubular opening, numeral 30 in the punching end face. A second embodiment is shown in Figure 7 and 8 of the patent drawings. This embodiment discloses a punching end face defined by two oblique diametrically intersecting planes defining radial apices perpendicular to the axis and including a tubular opening 60 in the end of the punch.

During the prosecution of the case applicants abandoned all claims directed to the embodiment shown in

Figures 1, 2 and 3 and limited their claims to the embodiment reflected in Figures 7 and 8.

(22) For reasons mentioned with reference to plaintiff's 2,950,637 patent, at the time patentees applied for plaintiff's 2,990,731 patent they were not the inventors of a device to be affixed to a main to provide a branch connection, nor were they first to devise a self punching T fitting, nor were they first to propose a screw thread advanced punch. Plaintiff's 2,990,731 patent was also anticipated in these respects by the disclosures in plaintiff's 2,950,637 patent.

(23) At the time Merrill, et al. made their application for plaintiff's patent 2,990,731 they were not the first to conceive of a punch having a hollow end face. The hollow end face punch is shown to be old in the following prior patents: Rowell No. 303,950, issued August 19, 1884; Smith No. 396,177, issued January 15, 1889; Dixon No. 2,251,701, issued August 5, 1941; Carlson No. 578,209, issued March 2, 1889; Peevey, et al. No. 2,606,615, issued August 12, 1952; Metz No. 1,020,302, issued March 12, 1912; and Alsaker No. 1,638,230, issued August 9, 1927. The patents to Rowell, Smith, Dixon, Carlson and Alsaker were not considered by the examiner.

(24) To utilize a hollow punch shown by Smith, Dixon, Carlson, Peevey, Metz or Alsaker in a self punching T as disclosed in McDonald, Webber or Hunter produces no unobvious results and would be within the ordinary skill of the art. Plaintiff's 2,950,637 patent is invalid as being anticipated by the prior art. Furthermore, the claims of this patent are invalid as including nothing more than the ordinary skill of a workman in the art, and do not disclose invention over the prior art.

(25) Reference to the file wrapper history of prosecution of plaintiff's 2,990,731 patent, discloses that the examiner rejected all of the original claims submitted on his

first action. Applicants responded to the rejection and argued for allowance of the claims. The claims had been rejected by the examiner in view of McDonald, Metz, Kenard and Peevey, et al. In their response patentees argued that the provision of a hollow end face punch produced,

> "cold flow of the metal at a localized area to be perforated, so as to produce the perforation. During the process of forming the hole by use of applicant's device, the metal is treated as a plastic and is gradually displaced or stretched or cold flowed until it fails at an opening."

Later in the discussion of supposed distinctions in applicants device applicant stated,

> "it is submitted that the structural definitions clearly define the claims over the references which lacked the particular combination of characteristics or structural properties mentioned above and which are incapable of performing the service of perforating a steel pipe by removing a plug or slug portion therefrom."

The patent to Alsaker issued August 9, 1927, which the examiner did not have before him when considering the application from which plaintiff's patent 2,990,731, issued provides at Page 1, Column 2, beginning at line 95 thereof:

> "the secret of operation to the best advantage was found in limiting the working surface of the said screw which is in contact with the work, that is the wall of the pipe, to as small a value as possible so as to increase the unit pressure which may be brought upon the work to cause it to yield or flow and also to limit the friction which is involved in the work of forming the perforations."

The patent to Alsaker thus teaches the same mode of operation to produce the same results, that is to punch or

swage a plug or slug in the wall of a pipe by the cold flow of metal. Thus the patent to Alsaker discloses that the mode of operation claimed to be new by applicants in the prosecution of both the patents in suit was old and well known in the art.

(26) In the prosecution of plaintiff's 2,990,731 patent, the applicants, in making an argument over the rejection of the claims by the examiner in view of the prior patents to McDonald and Metz specifically set forth what is meant by the claim terminology. The examiner had rejected the claims over Metz which disclosed a hollow punch formed by four oblique intersecting planes which define radial apices at an angle to a plane drawn perpendicular to the axis of the punch. In arguing the distinction in the claimed device applicants stated,

> "thus the provision of a number of flat bevels 3 exceeding two in the construction of Metz results in the formation of points 2 which are located at the inner diameter of the tool. Such points may be effective for working or punching belts or leather but obviously would not be effective or efficient for use in perforating steel pipe and would be subject to the same deficiencies as the patent to Peevey discussed above. Certainly, Metz does not disclose the diametrical intersection of two oblique planes to define a pair of aligned wall-engaging edges 66, as herein claimed in as Claim 4, and which extend for the full thickness of the tubular wall portion 62 rather than constituting a point. Note also that in Claim 11 (which became Claim 4 in the issued patent) the extension of these apices 66 perpendicular to the axis of the end portion of the tool is defined, a characteristic clearly lacking in Metz."

Defendant's exhibit No. 2, which is an enlarged model of the punching end configuration of the accused device, when first applied to an ink pad and then set upon a sheet of paper, clearly discloses by the three dots formed on the paper that the construction does provide points in the inner periphery thereof just as is predicted by the applicants since the punching face is configured as having a number of flat bevels "exceeding two in construction." The construction of the accused device includes the characteristic of the punch shown in the Metz patent which the applicants argued is distinguished from the claimed device. Since in obtaining the allowance of the claims of patent 2,990,731, applicants distinguish over a punch defined by more than two planes they have thereby distinguished the claims from the accused device which does in fact have more than two planes.

(27) In the prosecution by which Patent No. 2,990,731 was obtained, the applicants argued,

> "the examiner says that whether two or four well edges are used appears to be no more than arbitrary mechanical design. That statement is believed to overlook the fact that there is a considerable difference between a radially extending edge of the full thickness of the wall of a tube, as at 66 in applicant's construction, and a point located only at the inner periphery of the tool as in Metz."

Since the accused device contains the structural deficiencies which applicants rejected in avoidance of Metz, the claims cannot now be expanded to describe the accused device.

(28) After a second rejection of the claims of the 2,990,731 patent, applicants cancelled all but five of their claims. The retained Claims 6 and 11 became Claims 3

and 4 when the patent issued and are the claims in suit. In order to obtain allowance of these claims applicants argued,

> "Thus the claims contain the following specific structural definitions applicable to the embodiment of figures 7 and 8. Claim 6 (Claim 3 of the patent) defines the following structure: 'said end face having a V-shaped profile defined by two oblique planes intersecting diametrically of said end face and displaced between 140 deg. and 160 deg.' "

The accused device does not have the "specific structural definition" on which applicant relied. The accused device does not have two oblique planes intersectiong diametrically but does in fact have three oblique planes which do not intersect diametrically.

In arguing for the allowance of Claim 11 (Claim 4 of the patent as issued) applicants argued that it contained the following specific structural definition:

> "The free edge of said tubular portion lying in oblique intersecting planes to define wall-engaging radial apices perpendicular to the axis of said end portion."

Since applicants relied upon such specific structural definitions they are limited in the scope of their claims to such specific definitions. Although, the accused device provides radial apices, such apices are not "perpendicular to the axis of said end portion" but are at an angle of 6½ degrees to a plane drawn perpendicular the axis of the punching member. Since applicants limited the scope of their claim to obtain allowance of them to such "specific structural definitions" they cannot now expand the terminology of their claims beyond such specific structural definitions. The accused device is not defined by patentee's specific structural definitions.

(29) Claim 3 of plaintiff's 2,990,731 patent requires, as a positive element thereof, an "end face having a V-shaped profile defined by two oblique planes intersecting diametrically of said end face." Such structure is not found in the accused device and therefore the accused device does not infringe this claim.

(30) Claim 4 of Plaintiff's 2,990,731 patent requires a "punch having the free edges lying in oblique intersecting planes to define wall-engaging radial apices perpendicular to the axis of said end portion." Such structure is not found in the accused device therefore the accused device does not infringe this claim.

(31) The patents in suit are each directed to an exceedingly crowded field of art and are thus limited to a narrow range of equivalency. The patentees were not the first to enter such field. Any contribution of patentees was limited to exercise of mechanical skill and there is not disclosed in the patents any contribution rising to the level of invention.

(32) Claim 4 of plaintiff's 2,990,731 patent is directed to a combination of elements constituting a self punching T-fitting. All of the elements making up the claimed combination are disclosed in each of the prior issued patents to McDonald, Webber, and Hunter. The only difference in the claimed structure and the combination of elements shown in these prior issued patents is found in the punching end configuration. Having made a purported improvement in this single element patentees did not patent the improved element but claimed the entire combination. This claim is drawn to an unpatentable old and exhausted combination.

(33) The manufacture and sale of hollow tip self punching T-fitting devices by plaintiff, defendant and

others has been at a commercially successful level. However, the product has not replaced other devices long manufactured, sold and used for the same purpose and which have been on the market years prior to the appearance of self punching tee and has not supplanted other methods to a degree indicating the fulfillment of a long felt need.

Conclusions of Law.

Upon and pursuant to the foregoing findings of fact the court concludes as a matter of law:

(1) The court has jurisdiction of the parties and the subject matter of this action.

(2) United States Patent 2,950,637 is invalid and void.

(3) The manufacture and sale by the defendant of the accused device was not an infringement of Claims 1, 2, 3 and 10 of patent No. 2,950,637.

(4) United States Patent 2,990,731 is invalid and void.

(4) The manufacture and sale by the defendant of the accused device was not an infringement of claims 3 and 4 of patent No. 2,990,731.

(6) Plaintiff should take nothing upon its complaint against the defendant, but defendant should have judgment of the issues joined thereon, and the complaint should be dismissed upon the merits.

(7) Upon its counterclaim defendant should have judgment declaring United States patents 2,950,637 and 2,990,731 to be invalid, void and unenforceable in law, and further should have judgment declaring that the accused device is not an infringement of Claims 1, 2, 3 and 10 of patent 2,950,637 and Claims 3 and 4 of patent 2,990,731.

(8) Defendant should have judgment for its costs to be taxed pursuant to the rules of the court.

Dated at Tulsa, Oklahoma this 17th day of February, 1963.

Luther Bohanon,
U. S. District Judge.

Form Approved:

Horace D, Ballaine, for Plaintiff. R. B. McDermott, Paul H. Johnson for Defendant.

Filed Feb. 17, 1964.

Judgment.

Upon and pursuant to separate findings of fact and conclusions of law entered herein, it is adjudged and decreed:

(1) The plaintiff shall take nothing against the defendant upon its complaint, and the same complaint is dismissed upon the merits.

(2) Upon the defendant's counterclaim, United States Patents 2,950,637 and 2,990,731 are adjudged to be invalid, void and unenforceable at law.

(3) Further, upon defendant's counterclaim, it is adjudged that the devices of the defendant accused in this action do not infringe Claims 1, 2, 3 and 10 of patent 2,950,637 and Claims 3 and 4 of patent 2,990,731.

(4) The defendant shall have and recover against the plaintiff its costs to be taxed in accordance with rule 17(e) of the rules of this court.

Dated at Tulsa, Oklahoma this 17th day of February, 1963.

Luther Bohanon,
U. S. District Judge.

Form Approved:

Horace D. Ballaine, for plaintiff, R. B. McDermott, Paul H. Johnson for defendant.

Filed Feb. 17, 1964.

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1965.

No. 612

M. B. SKINNER COMPANY,
Petitioner,

vs.

CONTINENTAL INDUSTRIES, INC.,
Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

RICHARD B. McDERMOTT
300 Drew Building
Tulsa, Oklahoma 74103

PAUL H. JOHNSON
Beacon Building
Tulsa, Oklahoma 74103
Attorneys for Respondent.

E. L. MERDENHALL, 1108 Oak Street, Kansas City, Mo. 64106. HArrison 1-3030

TABLE OF CONTENTS

Opinions Below 1
Jurisdiction 1
Statutes Involved 2
Questions Presented 2
Statement of the Case 2
Argument 3
Question 1 3
Question 2 7
Conclusion 8

Table of Cases and Statutes

CASES

Atlantic Works v. *Brady*, 107 U. S. 192, 27 L. Ed. 438, 2 S. Ct. 225 (1883) 5, 6
Brown v. *Piper*, 91 U. S. 44 6
Crest Specialty v. *Trager*, 341 U. S. 912, 95 L. Ed. 1349, 71 S. Ct. 733 (1951) 6
Cuno Engineering Corp. v. *Automatic Devices Corp.*, 314 U. S. 84, 86 L. Ed. 58, 62 S. Ct. 37 (1941) 5-6
Great A&P Tea Co. v. *Supermarket Equip. Corp.*, 340 U. S. 147, 95 L. Ed. 162, 71 S. Ct. 127 (1951) 6
Hill v. *Wooster*, 132 U. S. 693, 33 L. Ed. 502, 10 S. Ct. 206 (1890) 6
Hotchkiss v. *Greenwood*, 52 U. S. 248, 13 L. Ed. 683 (1850) 4, 5
Mahn v. *Harwood*, 112 U. S. 354, 355, 28 L. Ed. 665, 667, 5 S. Ct. 174 (1884) 6
McClain v. *Ortmayer*, 141 U. S. 419, 35 L. Ed. 800, 12 S. Ct. 76 (1891) 6

Reckendorfer v. *Faber*, 92 U. S. 347, 23 L. Ed. 719 (1876) 5, 6

Slawson v. *Grand Street R. R. Co.*, 107 U. S. 649, 652, 27 L. Ed. 576, 577, 2 S. Ct. 663 (1883) 6

Thompson v. *Boisselier*, 114 U. S. 1, 29 L. Ed. 76, 5 S. Ct. 1042 (1885) 6

Williams Mfg. Co. v. *United Shoe Machinery Corp.*, 316 U. S. 364 (1942), 86 L. Ed. 1537 8

STATUTES

35 U. S. C. 102 (a) and (b) 2, 5, 7

35 U. S. C. 103 ..... 2, 3, 4, 5, 6, 7

Senate Report No. 1979 ..... 2, 5

CONSTITUTION

Article I, Section 8, cl. 8, Constitution 2, 5

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BRIEF OF RESPONDENT IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

Respondent opposes the prayer of the Petition that Writ of Certiorari issue to review the judgment to which it is addressed, and respectfully prays consideration of the following:

OPINIONS BELOW

The findings and opinions of the lower courts are correctly reflected in the Appendix to the Petition.

JURISDICTION

The Petition is timely, and sufficiently invokes jurisdiction of this Court under 28 U. S. C., Section 1254 (1).

STATUTES INVOLVED

While the Petition refers only to that Section of the 1952 Patent Act which is coded at 35 U. S. C., Section 103, its proper disposition will require additional reference to 35 U. S. C., Section 102, to Senate Report No. 1979 reflecting legislative history, and to Article I, Section 8, cl. 8, of the Constitution of the United States.

QUESTIONS PRESENTED

Respondent disagrees emphatically that the questions as proposed by the Petition arise upon the record and judgments below.

Neither the judgment of the trial court, nor the opinion of the Court of Appeals is rested upon the determinations postulated by Petitioner, and which are necessarily postulated to derive its "Questions Presented".

The questions proposed, if they arise at all upon this record, are wholly adjective to the judgments addressed. The judgments below would stand unaffected, even if Petitioner's thesis were sustained.

The two questions attempted to be presented are treated separately in the Argument.

STATEMENT OF THE CASE

Petitioner's statement of the case below is inadequate in a multitude of particulars, all of which need not be developed for the purposes of the pending issue.

It is specifically deficient, however, in its failure to disclose that both courts below held that the patent claims

in issue were obvious to one ordinarily skilled in the art (as well as not inventive, if this be a different standard), and therefore invalid. The trial court held this as a determination of fact,[1] and the Court of Appeals affirmed under familiar rules of decision. The trial court also held Respondent's accused device not to infringe, but the Court of Appeals did not review this question in view of its conclusion of invalidity.

ARGUMENT

Reasons for Refusal of the Writ

We address ourselves separately to the two questions presented in the Petition.

QUESTION 1.

Petitioner urges no conflict of decision and no issue of public importance to justify review by this Court of Question 1. The case for review rests solely on the contention that the court below:

> ". . . Applied a non-statutory and improper test of patentability." (Pet. 5)

The gist of petitioner's position is that Congress, by the enactment of 35 U. S. C. 103, abolished the constitutional requirement for invention and, for the first time, authorized the extension of patent monopolies to merely novel devices which do not exceed the skill of the art. Such a contention is at odds not only with the express intent of Congress as reflected by the legislative history of the 1952 Patent Act, but also with all of the apposite

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1. See Findings of Fact Nos. 11, 12, 13, 24, 25 and 31, found at pp. 47-54 of the Record below, and at pp. 31-40 of the Appendix to the Petition.

decisions of this Court, and with the practical application of the patent system since its inception.

Petitioner states:

> "The erroneous test of patentability applied by the court below was stated, in part, as follows:
>
> "'. . . since it is a combination of old elements appellant must show both that it accomplishes a new and useful result and is inventive.'" (Pet. 5)
>
> * * *
>
> ". . . Certainly, the statute (35 U. S. C. 103) does not require *both* a new result and inventiveness." (Pet. 5)[2] (Emphasis in original)
>
> * * *
>
> "The court of appeals and the district court further erred in holding that the combination must be *inventive* to be patentable. The statute merely states that the combination must be unobvious to one skilled in the art. It says nothing about the combination being *inventive.*" (Pet. 7) (Emphasis in original)

Thus, Petitioner urges that the "unobviousness" test of Section 103 is wholly satisfied by a "new . . . result" —*i.e., merely novelty.* The failure of the lower courts to find a new result, and their direct finding of obviousness is ignored.

At least since the 1850 decision in *Hotchkiss* v. *Greenwood*, 52 U. S. 248, 13 L. Ed. 683 (1850), this Court has enforced the constitutional "requirement for invention" as a *separate, non-statutory* (until the enactment of Sec-

---

2. In point of fact neither court below found that the combination of old elements in issue accomplished either "a new result" or that such combination was "inventive". Petitioner is thus forced to the extreme "position that failure to find a new result from the combination of old elements has no bearing on whether the improvement was obvious to those skilled in the art." (Pet. 7)

tion 103) prerequisite to patentability in addition to the *statutory* requirements of *novelty* and utility.

The fundamental distinction between "novelty" and "invention" was expressly preserved by Congress in the 1952 Patent Act.

35 U. S. C. *102(a)* and (b) was a recodification. It "repeats the conditions in the existing law (R. S. 4886) relating to novelty." (Sen. Rep. No. 1979, p. 5)[3]

35 U. S. C. *103*, one of the "major changes or innovations" (Sen. Rep. 1979, p. 4) of the 1952 Act was a codification of the pre-existing *non-statutory*, judge-made "requirements for invention." (Sen. Rep. 1979, p. 4)[4] which had "existed in the law for more than a hundred years, but only by reason of the decisions of the Courts." (Sen. Rep. 1979, p. 6)[5]

The "decisions of the Courts" enunciating the constitutional "requirement for invention" codified in Section 103 uniformly hold that "promotion of science and the useful arts" (Const., Art. I, Sec. 8, cl. 8) requires as a minimum, not merely *novelty*, but a contribution exceeding "the skill of the art . . ." —in other words, "invention." *Hotchkiss* v. *Greenwood*, 52 U. S. (11 How.) 248, 13 L. Ed. 683 (1850); *Atlantic Works* v. *Brady*, 107 U. S. 192, 27 L. Ed. 438, 2 S. Ct. 225 (1883); *Reckendorfer* v. *Faber*, 92 U. S. 347, 23 L. Ed. 719 (1876); *Cuno Engineer-*

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3. The Revisor's note states:
"Paragraphs (a), (b), . . . are based on . . . RS 4886. . . .
". . . no change is made in these paragraphs other than that due to division into lettered paragraphs. . . ."

4. Senate Report No. 1979 states:
". . . The major changes or innovations in the title consist of incorporating *a requirement* for invention in § 103 and the judicial doctrine of contributory infringement in § 271."

5. See the quotation from Senate Report 1979, Petition, pp. 8, 9.

ing Corp. v. *Automatic Devices Corp.*, 314 U. S. 84, 86 L. Ed. 58, 62 S. Ct. 37 (1941); *Great A&P Tea Co.* v. *Supermarket Equip. Corp.*, 340 U. S. 147, 95 L. Ed. 162, 71 S. Ct. 127 (1951); *Crest Specialty* v. *Trager*, 341 U. S. 912, 95 L. Ed. 1349, 71 S. Ct. 733 (1951).

Of perhaps even greater significance is the fact that the interpretation of 103 to eliminate the "requirement for invention" as urged by Petitioner would impede "the progress of science and the useful arts" by authorizing patents for trifles in derogation of the Constitution as consistently construed by this Court for over a century. *Atlantic Works* v. *Brady*, 107 U. S. 192, 27 L. Ed. 438, 2 S. Ct. 225 (1883); *Thompson* v. *Boisselier*, 114 U. S. 1, 29 L. Ed. 76, 5 S. Ct. 1042 (1885); *Hill* v. *Wooster*, 132 U. S. 693, 33 L. Ed. 502, 10 S. Ct. 206 (1890); *McClain* v. *Ortmayer*, 141 U. S. 419, 35 L. Ed. 800, 12 S. Ct. 76 (1891); *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 86 L. Ed. 58, 62 S. Ct. 37 (1951); *Great A&P Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 95 L. Ed. 162, 71 S. Ct. 127 (1951); *Crest Specialty* v. *Trager*, 341 U. S. 912, 95 L. Ed. 1349, 70 S. Ct. 733 (1951).

Cognizant of the constitutional limitation on the patent power, this Court emphasized for many years that the defense of "no invention" might be raised in the absence of a statute (*Reckendorfer* v. *Faber*, 92 U. S. 347, 23 L. Ed. 719 (1876); *Mahn* v. *Harwood*, 112 U. S. 354, 355, 28 L. Ed. 665, 667, 5 S. Ct. 174 (1884); *Great A&P Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 95 L. Ed. 162, 71 S. Ct. 127 (1951)) and *sua sponte* by the Court even if not pleaded by the infringer (*Brown* v. *Piper*, 91 U. S. 44; *Slawson* v. *Grand Street R. R. Co.*, 107 U. S. 649, 652, 27 L. Ed. 576, 577, 2 S. Ct. 663 (1883)).

There would have been no reason for Section 103 if the "obviousness" test it defines were implicit in the re-

quirement for *novelty* now *recodified* in 35 U. S. C. 102. In such a case, Section 103, far from being a "new statute" constituting one of the two acknowledged "major changes or innovations" in the 1952 Patent Act would have been an exercise in congressional futility.

The decision below applied the proper "test of patentability." The petition should be denied as to Question 1.

QUESTION 2.

Question 2 presents an artificial issue inconsistent with the opinions of both lower courts and with the fact findings of the trial court.

Question 2 is concerned solely with Petitioner's second patent 2,990,731 which substitutes in the device of the first patent 2,950,637 an improved punching element provided with a hollow tip. Contrary to Petitioner's argument, the court below properly recognized that the hollow tipped punch was:

> ". . . the dominant element of the invention as claimed." (Pet. 12)

The court below found the hollow tipped punch *element* to be old and invalidated the claim on expressly the basis of such finding. The court said:

> "Much of what has been said about patent 2,950,637 applies to the second patent, number 2,990,731. *The only question here concerns the different punching-tip configuration.* The idea of a perforating tool with a hollowed end was used, *inter alia,* by Metz, patent number 1,020,302, in 1912, and by Alsaker, *supra.* The key to the punching tip, the formation by intersecting planes with a hollow tip, was used by Metz, *supra,* and shown by Alsaker, *supra.* Appellant complains that these inventions are different, since each

design embodied more than two intersecting planes. However, a mere difference in the number of planes and corresponding apexes, if inventive, suggests severable patentability rather than combination; **and, in any case, appellant was anticipated by Alsaker's statement that 'while I have shown four such cutting edges, obviously a less or greater number might be employed without departing from the invention.'** This statement is of particular significance because the Alsaker patent was not considered by the patent office." (Pet. 23-24) (Emphasis added)[6]

There is no conflict between the decision below and the decision of this Court in *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364 (1942). (Pet. 12-14) The Court below clearly recognized that "It is only the improved punching tip which is claimed and not the remaining elements of the T-fitting in which the punching tip is used." (Pet. 14)

It found that "the improved punch tip, *per se*" (Pet. 14) was old and properly invalidated the patent.

CONCLUSION

For the foregoing reasons Respondent respectfully submits that the Petition for Writ of Certiorari should be denied.

RICHARD B. MCDERMOTT
300 Drew Building
Tulsa, Oklahoma 74103

PAUL H. JOHNSON
Beacon Building
Tulsa, Oklahoma 74103
Attorneys for Respondent.

6. The second quotation at Pet. 12 is of a *partial* sentence. It significantly omits the portion of the opinion reproduced in bold face above which demonstrates the inaccuracies in Petitioner's argument.

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No. 612

M. B. SKINNER COMPANY,

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vs.

CONTINENTAL INDUSTRIES, INC.,

Respondent.

PETITIONER'S BRIEF IN REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI.

CHARLES J. MERRIAM,
NORMAN M. SHAPIRO,
ALLEN H. GERSTEIN,
Attorneys for Petitioner.

Of Counsel:
MERRIAM, MARSHALL, SHAPIRO & KLOSE,
30 West Monroe St.,
Chicago, Illinois 60603.

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CONTINENTAL INDUSTRIES, INC.,

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PETITIONER'S BRIEF IN REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI.

Respondent's brief not only fails to address itself to the questions presented in the Petition but erroneously characterizes those questions.

The first question presented by petitioner deals with the erroneous standard of patentability applied by the courts below. Based on a scrambling of statements taken from the decision below and the Petition, respondent mistakenly characterizes petitioner's argument as: "Thus, Petitioner urges that the 'unobviousness' test of Section 103 is wholly satisfied by a 'new . . . result'—*i.e., merely novelty.*" (Br. 4) (Emphasis in original.)

Petitioner has never made such an argument. It is clear from even a most strained interpretation of the petition

that unobiousness is not equated with novelty. The Petition states: "It is petitioner's position that failure to find a new result from the combination of old elements has no bearing on whether the improvement was obvious to those skilled in the art." (Pet. 7.) Nor does petitioner assert that the Constitutional provision (Act I, Sec. 8) is limited to requiring novelty only. The Petition also states: "The statute only requires that the combination be unobvious to one skilled in the art." (Pet. 5.)

Respondent's discussion of question 1 is therefore entirely meaningless because it fails to direct itself to the question presented.

Question 2 involves the lower court's improper characterization of claims 1, 2 and 3 of Patent 2,990,731 as combination claims. Respondent argues that even if these claims are directed to the punching element only, the courts below specifically held those claims anticipated by the Alsaker reference. Respondent fails to note that portion of the court of appeals' opinion cited previously at Pet. 12: "There is no single aspect of appellants T-fittings that is totally new, with the possible exception of the punching tip *which is different from the prior art relied upon by appellee and the Patent Office.*" (Emphasis added.) 346 F. 2d 173. Since the tip is different there obviously could be no anticipation.

The courts erred in not finding the claims directed to a tip per se but if, as respondent argues, the court of appeals did hold the claims directed to the tip per se it erred in finding the claims anticipated.

Conclusion.

Petitioner respectfully requests that a Writ of Certiorari issue for the reasons set forth in its Petition.

Respectfully submitted,

CHARLES J. MERRIAM,
NORMAN M. SHAPIRO,
ALLEN H. GERSTEIN,
Attorneys for Petitioner.

Of Counsel:
MERRIAM, MARSHALL, SHAPIRO & KLOSE,
30 West Monroe St.,
Chicago, Illinois 60603.

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PETITION FOR REHEARING OF ORDER DENYING PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT.

CHARLES J. MERRIAM,
NORMAN M. SHAPIRO,
ALLEN H. GERSTEIN,
NATE F. SCARPELLI,
Attorneys for Petitioner.

Of Counsel:
MERRIAM, MARSHALL, SHAPIRO & KLOSE,
30 West Monroe St.,
Chicago, Illinois, 60603.

THE BUNTHORP-WARREN PRINTING COMPANY, CHICAGO

IN THE

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Respondent.

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT.

Petitioner respectfully requests a rehearing of its Petition for a Writ of Certiorari denied by this Court. 34 U. S. L. Week 3304 (U. S. March 7, 1966).

This is a patent infringement case wherein petitioner contends that the court of appeals and the district court failed to apply the correct standard of patentability as set forth in 35 U. S. C. § 103.

Subsequent to the filing of the petitioner for writ of certiorari here, the same court of appeals decided *King-Seeley Thermos* v. *Refrigerated Dispensers,* 354 F. 2d 533 (10th Cir. 1965), in which the standard of patentability

there applied was in direct and irreconcilable conflict with the standard applied by that court in the instant case. More important, the decision below in the instant case is also in direct and irreconcilable conflict with this Court's recent decision in *Graham* v. *John Deere Co.*, 34 U. S. L. Week 4119 (U. S. February 21, 1966). These conflicts did not exist and could not be anticipated when the Petition for Writ of Certiorari was filed on September 24, 1966.

In setting forth its interpretation of the standard of patentability in the instant case, the court of appeals said:[1]

> "Appellant's claims of invention therefore are based upon what is said to be a new combination of elements, and since it is a combination of old elements appellant must show both that it accomplishes *a new and useful result and is inventive. Williams Iron Works Co.* v. *Hughes Tool Co.*, 10 Cir., 109 F. 2nd 500. . . . The standards of originality necessary to sustain a patent based upon a combination of old elements are properly burdensome. *Ditto, Inc.* v. *Minnesota Mining & Mfg. Co.*, 8 Cir., 336 F. 2d 67; *John Deere Co.* v. *Graham*, 8 Cir., 333 F. 2d 529, cert. granted, 379 U. S. 956." (Emphasis added.)

In *King-Seeley*, decided December 27, 1965, another panel of the same Circuit said at 354 F.2d 536-7:

> "A combination of various elements already known to the art is patentable if it accomplishes *either a new or an old result* 'in a more facile, economical and efficient way in a particular environment which presented peculiar and difficult problems.' " (Emphasis added.)

Since the filing of the petition for writ of certiorari in the instant case and the later contrary decision of the Tenth Circuit in *King-Seeley*, this Court considered three cases

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1. 346 F. 2d 170 at 173-4.

involving the standard of patentability under 35 U. S. C. § 103[2] and delivered its decision on February 21, 1966.[3]

In *Graham* v. *John Deere Co.*, 34 U. S. L. Week at 4119, this Court said:

> "In 1955, the Fifth Circuit had held the patent valid under its rule that when a combination produces an 'old result in a cheaper and otherwise more advantageous way,' it is patentable. *Jeoffroy Mfg., Inc.* v. *Graham*, 219 F. 2d 511, cert. denied, 350 U. S. 826. In 1964, the Eighth Circuit held, in the case at bar, that there was no new result in the patented combination and that the patent was, therefore, not valid. 333 F. 2d 529, reversing 216 F. Supp. 272. We granted certiorari, 379 U. S. 956. *Although we have determined that neither Circuit applied the correct test,* we conclude that the patent is invalid under § 103 and, therefore, we affirm the judgment of the Eighth Circuit." (Emphasis added.)

As elicited by this Court, "patentability is dependent upon three explicit conditions: novelty and utility as articulated and defined in § 101 and § 102, and non-obviousness, the new statutory formulation, as set out in § 103." 34 U. S. L. Week 4121.

A standard of patentability requiring a new *result,* such as that enunciated below, is entirely inconsistent with the Tenth Circuit's later decision in *King-Seeley,* and with this Court's decision in *John Deere.*

Instead of directing itself to the question of whether the subject matter of the combination was novel, useful and unobvious, the Tenth Circuit here said it must be shown that the combination "accomplishes a new and useful *result* and is inventive." (Emphasis added.)

---

2. *Graham* v. *John Deere; Calmar* v. *Cook Chemical Co.;* and *United States* v. *Adams.*

3. Reported at 34 U. S. L. Week 4119-35.

In *Graham* v. *John Deere*, 34 U. S. L. Week at 4122, this Court said:

> "... Congress has emphasized 'non-obviousness' as the operative test of the section, rather than the less definite 'invention' language of *Hotchkiss* that Congress thought had led to 'a large variety' of expressions in decisions and writings. In the title itself, the Congress used the phrase 'Conditions for patentability: *non-obvious subject matter,*' thus focusing upon 'non-obviousness' rather than 'invention'. The Senate and House Reports, S. Rep. No. 1979, 82d Cong., 2d Sess. (1952); H. R. Rep. No. 1923, 82d Cong., 2d Sess. (1952), reflect this emphasis in these terms."

The district court in its findings (adopted verbatim from respondent) never mentioned § 103 nor did it focus on the standard of non-obviousness as recently defined by this Court.

Specifically, the pertinent district court findings recite that appellant's device produced "no unobvious *results* and would be within the ordinary skill of the art",[4] "produces no new or unobvious *result* to a worker ordinarily skilled in the prior art",[5] "produces no new or unobvious *result* that would not be suggested to a worker skilled in the art",[6] and "produces no unobvious *results* and would be within the ordinary skill of the art."[7]

Thus, these findings clearly reflect an erroneous test of patentability, *i.e.*, whether the *results* were unobvious rather than whether the *subject matter of the combination was unobvious* as required by section 103 and the authority of this Court's recent decisions.

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4. Findings of Fact 11, Petn. 31.
5. Findings of Fact 12, Petn. 31.
6. Findings of Fact 13, Petn. 31-32.
7. Findings of Fact 24, Petn. 35.

It is well established that the denial of a writ of certiorari is not an affirmance by this Court of the decision below. *Brown* v. *Allen,* 344 U. S. 443 (1953). With that fact in mind, petitioner filed a Petition for Rehearing *En Banc* in the Tenth Circuit on March 16, 1966 (eight days subsequent to this Court's denial of the Petition for Writ of Certiorari) seeking to have the court of appeals resolve the conflict between its decision in the instant case, the *King-Seeley* case, and *Graham* v. *John Deere.* Petitioner is now awaiting the decision of the court of appeals.

Under Rule 58 of the Supreme Court, an unsuccessful petitioner for writ of certiorari has 25 days from denial of the petition to seek a rehearing. The facts being what they are, petitioner finds itself all dressed up with a meritorious and just argument but with no place to go if the court of appeals denies the Petition for Rehearing *En Banc* after 25 days have passed from the denial of the writ. Petitioner will be denied due process of law, since it was not afforded a proper hearing wherein the controlling rule of law was correctly applied.

Petitioner respectfully prays for an order either: (a) granting its petition for writ of certiorari, (b) remanding the case to the court of appeals for hearing in accordance with this Court's controlling decision in *Graham* v. *John Deere,* or (c) holding the present petition for rehearing in abeyance until there is a disposition by the court of appeals, and if that disposition be adverse to petitioner, granting petitioner leave to file a new or supplemental petition for writ of certiorari or petition for rehearing.

Petitioner is mindful of the unusual nature of its prayer but submits that it is justified by the unusual nature of the facts involved.

Respectfully submitted,

CHARLES J. MERRIAM,
NORMAN M. SHAPIRO,
ALLEN H. GERSTEIN,
NATE F. SCARPELLI,
30 West Monroe Street,
Chicago, Illinois,
Attorneys for Petitioner.

Of Counsel:
MERRIAM, MARSHALL, SHAPIRO & KLOSE,
30 West Monroe Street,
Chicago, Illinois.

CERTIFICATE.

Norman M. Shapiro certifies that the foregoing Petition is presented in good faith and not for delay and is restricted to the grounds specified in Rule 58 of the Rules of this Court.

NORMAN M. SHAPIRO,
30 West Monroe Street,
Chicago, Illinois.